

DISPUTE RESOLUTION SERVICE

D00017069

Decision of Independent Expert

Vodafone Group Plc

and

Number Direct

1. The Parties:

Lead Complainant: Vodafone Group Plc
Vodafone House, The Connection,
Newbury,
Berkshire
RG14 2FN
United Kingdom

Respondent: Number Direct
4 Sinclair Way
Prescot
Merseyside
L34 1QL
United Kingdom

2. The Domain Name(s):

vodafone-customer-service.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

09 February 2016 11:46 Dispute received

09 February 2016 12:00 Complaint validated

09 February 2016 12:02 Notification of complaint sent to parties

26 February 2016 01:30 Response reminder sent

02 March 2016 08:17 No Response Received

02 March 2016 08:17 Notification of no response sent to parties

08 March 2016 10:50 Expert decision payment received

4. Factual Background

- 4.1. The Complainant is the mobile communications network operator, Vodafone Group plc.
- 4.2. The Complainant is one of the world's largest mobile communications companies by revenue. It operates worldwide through numerous subsidiaries and provides a wide range of communications services.
- 4.3. The Complainant is listed on both the London Stock Exchange and on NASDAQ. As at 28 January 2015 it had a market capitalisation of approximately £62.79 billion and in the financial year ended 31 March 2014 it generated revenue of £43.6 billion. The Complainant (and its group) has over 404 million mobile customers in over 30 countries worldwide.
- 4.4. The Complainant holds a total of 1,531 registered and pending trade marks for and including the word VODAFONE. 41 of these are in the UK and 55 are EU registrations.
- 4.5. Additionally, the Complainant owns over 200 Domain Names consisting of exclusively the mark VODAFONE as well as more than 400 Domain Names in which VODAFONE is used in combination with other words and/or numbers.
- 4.6. The Respondent is Number Direct.

- 4.7. The Respondent registered the Domain Name on 30 August 2013.
- 4.8. The Domain Name is directed to a site which is clearly headed Number Direct and then carries the sub-heading VODAFONE CUSTOMER SERVICES. The homepage of the site also has the VODAFONE logo on it. The site itself contains a great deal of information about the Complainant including latest news stories concerning the Complainant. It features a telephone number to contact, "VODAFONE CUSTOMER SERVICES".
- 4.9. No Response has been filed by the Complainant.

5. Parties' Contentions

Complainant's Submissions

Rights

- 5.1. The Complainant provides a great deal of evidence in support of its contention that it has Rights in a name or mark which is similar or identical to the Domain Name. I will attempt to summarise this in the following paragraphs.
- 5.2. The Complainant is one of the world's largest mobile communications companies by revenue. It operates worldwide through numerous subsidiaries in over 30 countries across six continents.
- 5.3. As at 28 January 2015 the Complainant had a market capitalisation of approximately £62.79 billion and in the financial year ended 31 March 2014 the Complainant generated revenue of £43.6 billion. Its shares are traded on both the London Stock Exchange and the NASDAQ.
- 5.4. The brand name VODAFONE was coined in 1984 and encompasses the elements "voice", "data" and "phone".
- 5.5. Through its extensive sales, advertising and marketing around the world the Complainant has acquired a very substantial reputation in both the VODAFONE brand and associated brands. The 2014 BrandFinance Global 500 ranked VODAFONE as the 16th most valuable brand in the world and the 5th most valuable global telecommunications brand.

- 5.6. The Complainant has been successful in a number of UDRP complaints and in those complaints the WIPO panellists have consistently found that VODAFONE is a well-known trade mark.
- 5.7. The Complainant holds 1,531 registered and pending trade marks for and including the word VODAFONE Worldwide (including 41 in the UK and 55 EU registrations).
- 5.8. The Complainant owns over 200 Domain Names consisting exclusively of the mark VODAFONE as well as more than 400 domain names in which VODAFONE is used in combination with other words and/or numbers.
- 5.9. The Domain Name is for all intents and purposes identical to the mark protected by many of the Complainant's earlier trade mark registrations as it wholly incorporates the VODAFONE element of the Complainant's registrations. The additional "-customer service" element is of a descriptive nature as customer service provisions are a well known and understood element of any consumer facing business. These are services the Complainant offers and would be expected to offer. This element simply serves to reinforce the use of the VODAFONE brand as it would be recognised that the customer service relates to VODAFONE.

Abusive Registration

- 5.10. The Complainant contends that the Domain Name is an Abusive Registration for the reasons that I will attempt to summarise in the following paragraphs.
- 5.11. The Complainant relies on previous UDRP decisions which have found that it is hardly conceivable that third parties will have adopted domain names which include the mark VODAFONE without having knowledge of the Complainant's well-known trade mark VODAFONE.
- 5.12. The Complainant relies on Paragraph 3(a)(ii) of the Policy and contends that the setup of the website and the different pages are such that users of the site would believe the Complainant has control of the Domain Name when in fact this is not the case. This is allowing the Respondent to profit from the confusion it has created. Such a website is also a high risk to the reputation of the Complainant.
- 5.13. The website to which the Domain Name points is clearly structured to represent that the Respondent is associated with and providing services connected to the

Complainant. For example the, "About Us" section of this website clearly sets out the history and background of the Complainant and any visitor to this site would assume that the site is therefore run by the Complainant. Additionally, the home page of the site also makes prominent use of the Complainant's logo and this serves to create a clear link in the mind of the visitor that they viewing a website connected with the Complainant.

- 5.14. The site also includes a customer services number and the whole effect of the site is clearly to lead the user to believe that it is authorised by or connected with Vodafone. In fact, the number provided by the Respondent is not a, "free to call" number but costs 5p per minute which is clearly intended to generate an income for the Respondent. The Respondent is therefore clearly profiting from the confusion it has set out to cause by virtue of their use of the Domain Name and the repeated references to the Complainant.
- 5.15. The Complainant confirms that there is no connection between the Complainant and the Respondent or the Respondent's site and the Respondent's use of the Domain Name is therefore unacceptable.
- 5.16. The Complainant also notes that there is a high risk of confusion where the Domain Name is used for the purposes of email and emails from the Domain Name would be regarded as originating from the Complainant and in particular the Complainant's customer services team.
- 5.17. The Complainant also relies on initial interest confusion and refers to paragraph 3.3 of the Experts Overview in this regard. The Complainant contends that the mark Vodafone cannot refer to anything or anyone but the Complainant and therefore the public typing in the website www.vodafone-customer-service.co.uk would be confronted with the site as it currently appears allowing the Respondent to profit from the confusion. The Complainant contends that in this case the situation is worse than normal as anyone visiting the site as a result of initial interest confusion would be likely to remain confused as the customer who has visited the site by mistake would be likely to use the numbers on the website to try and reach the Complainant especially given the use of the Complainant's mark on the site. This confusion would not be abated as the number does ultimately reach the Complainant and the unsuspecting consumer would be none the wiser as to the deception.

Respondent's Submissions

5.18. The Respondent has not filed a Response.

6. Discussions and Findings

6.1. Paragraph 2(a) of Nominet's Dispute Resolution Policy ("the Policy") requires that the Complainant must prove, on the balance of probabilities, that:

- *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Rights

6.2. As a first step I must therefore decide whether the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name(s).

6.3. The definition of Rights in the Policy is as follows:

Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

6.4. This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.

6.5. I have no doubt that, on the balance of probabilities, the Complainant has Rights in the word or mark VODAFONE. This mark has had a very high level of use over a considerable period of time. It is also protected by an impressive portfolio of registrations

6.6. Having decided that the Complainant has Rights in the name or mark VODAFONE I must decide whether or not that name or mark is identical or similarly to the Domain Name. This differs from the name or mark VODAFONE only by the addition of the words "-CUSTOMER-SERVICE". These added words are clearly descriptive and add little or nothing to the trade mark part of the Domain Name which is the mark

VODAFONE. In other words the additional words “-CUSTOMER-SERVICES” will be naturally seen as simply describing the nature of services that VODAFONE provide and they do little or nothing to change the distinctive character of the mark VODAFONE.

6.7. I therefore conclude, on the balance of probabilities, that the Complainant has Rights in a name or mark which is identical or similar to each of the Domain Names.

Abusive Registration

6.8. Abusive Registration is defined in Paragraph 1 of the Policy as a domain name which either:

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or

(ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.

6.9. This definition requires me to consider whether the Domain Name is an Abusive Registration either at the time of registration/acquisition or subsequently through the use that was made of it.

6.10. Paragraph 3 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that a Domain Name is an Abusive Registration and Paragraph 4 of the Policy provides a non-exhaustive list of the factors which may constitute evidence that the Domain Name is not an Abusive Registration.

6.11. The Policy requires the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration. The burden of proof is therefore firmly on the Complainant.

6.12. In order to make a finding of Abusive Registration it is reasonably common ground amongst Nominet Experts that, in all but a minority of cases, there must be an element of knowledge on the part of the Respondent in the sense that the Respondent must, on some level, be aware of the Complainant’s Rights. In some cases where the name in which the Complainant has Rights is particularly well known this will be fairly obvious and straightforward while in other cases where the name in

which the Complainant has Rights is less well known and/or where there are other meanings or uses which can be made of the name this will require substantial evidence from the Complainant.

- 6.13. The position on knowledge has been summarised by Nominet's Appeal Panel in the earlier case of Verbatim Limited -v- Michael Toth DRS04331 and it is convenient to reproduce the following paragraphs from the Appeal Panel's decision here:

In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

First, some knowledge of the Complainant and/or its brands/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.

Secondly, "knowledge" and "intention" are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.

Thirdly, "intention" is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.

Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.

Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.

Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name.

- 6.14. The approach that I therefore intend to take in this case is to look at the overall question of whether the Respondent's registration or use of the Domain Names constitutes an Abusive Registration. Bound up with that, and indeed central to it, will necessarily be the question of the Respondent's knowledge of the Complainant's Rights.
- 6.15. In making this overall assessment the nature of the name or mark in which the Complainant has Rights is also clearly a factor here. The more descriptive or generic that name or mark is then the more likely it is that the Respondent simply happened upon the Domain Name(s) as a "good domain name(s)" without necessarily having any knowledge of the Complainant's Rights. Obviously the more well-known and unique that name or mark is then the less likely it is that the Respondent did not register the Domain Name(s) with the Complainant's Rights in mind.
- 6.16. In this case the Domain Name contains the word or mark Vodafone. As I have already said it also contains the words "customer" and "services" which would be commonly viewed as descriptive i.e. describing the nature of the services that are being offered by VODAFONE. The name or mark VODAFONE is very much at the end of the scale such that the registration of a domain name which included the word or mark VODAFONE will give rise to a prima facie case that the Domain Name was an Abusive Registration. Put another way, given the nature of the mark VODAFONE and the extensive use that has clearly been made of it, it is very difficult to think of a set of circumstances in which a third party could have registered or used a domain name consisting of or containing VODAFONE without knowledge of the Complainant.
- 6.17. In this case one only has to look at the website to which the Domain Name is pointed to know that the Respondent has registered the Domain Name with the Complainant and its Rights firmly in mind. The website contains a large amount of information about the Complainant and is designed to look like a site which is being provided by or at least connected to the Complainant. For example, it bears the Complainant's logo prominently on the home page and it also contains a great deal of information about the Complainant itself including about its history and links to a number of press

releases about the Complainant. The impression which is clearly intended to given is that the site is a customer service site operated by the Complainant through which users can contact the Complainant's customer services.

6.18. This by itself is more than enough to give rise to a finding of Abusive Registration. The use of the mark in which the Complainant has Rights in this way is clearly unfairly detrimental to that mark. However, when one considers that the website being operated by the Respondent and linked to the Domain Name also very prominently gives a phone number through which the user can reach the Complainant's real customer services department the conclusion that the Respondent is seeking to take unfair advantage of the Complainant's Rights also becomes irresistible. The Complainant submits that the user of this number will be charged for that phone call and some of that money will go to the Respondent. This seems entirely plausible and given this it also very clearly follows that, again on the balance of probabilities, the Domain Name is also being used to unfairly advantage the Respondent.

6.19. The Respondent has not put in a Response and indeed it is difficult to think of a credible explanation for the Respondent's conduct. I therefore have no hesitation in finding that on the balance of probabilities that the Domain Name is an Abusive Registration.

7. Decision

I find that, on the balance of probabilities, the Complainant has Rights in a name or mark which is identical or similar to the Domain Name. I also find that, on the balance of probabilities, the Complainant has established that the Domain Name is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed: Nick Phillips

Dated: 5 April 2016